

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Edward B. Keller, et al.	Art Unit:	3623
Application No.:	10/757,166	Examiner:	Susanna M. Diaz
Filed:	January 13, 2004	Confirmation No.:	3545
Title:	SYSTEM AND METHOD OF IDENTIFYING INDIVIDUALS OF INFLUENCE	Docket No.:	07055878

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**OBJECTION TO THE NEW GROUNDS OF REJECTION RAISED IN THE
EXAMINER'S ANSWER AND RESPONSE UNDER 37 C.F.R. § 1.111**

Applicants hereby file this objection to the new ground of rejection raised in the Examiner's Answer mailed October 30, 2008. In view of this objection, and solely to preserve its rights in view of the time limit provided in the Examiner's Answer mailed October 30, 2008, Applicants also submit the following response under 37 C.F.R. § 1.111, which addresses the decision of the Examiner dated February 25, 2008 and the new ground of rejection stated in the Examiner's Answer dated October 30, 2008. The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to Deposit Account No. 13-0019. This objection and response takes the following form:

Amendments to the Claims are presented on page 2; and

Remarks, including Applicants' objection to the new ground of rejection raised in the Examiner's Answer, are presented on page 12.

AMENDMENTS TO THE CLAIMS

1. (Currently amended) A method for identifying from demographic data those individuals in a population having a greater probability than other individuals in the population of influencing the choices made by others comprising:

- a. determining if each individual in a first population is influential;
- b. providing demographic data for each individual in the first population, wherein the demographic data corresponds to a set of demographic variables;
- c. identifying a plurality of predictive variables from the set of demographic variables such that the demographic data corresponding to the plurality of predictive variables substantially correlates to an individual in the first population being determined to be influential;
- d. calculating percent gains for each predictive variable as a measure of the correlation between the predictive variable and whether a person is an influential;
- e. creating a database scoring algorithm based upon the plurality of predictive variables and the percent gains;
- f. ~~validating the plurality of predictive variables to determine a final set of predictive variables and to create a~~ database scoring algorithm; and
- g. ~~providing demographic data for a second population, wherein the demographic data for the second population corresponds to the final set of predictive variables; and~~
- h. ~~applying the database scoring algorithm to the demographic data for the second population to determine a group of influential individuals, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population~~

~~in general~~ wherein at least one of the steps of identifying a plurality of predictive variables, calculating percent gains, and creating a database scoring algorithm is performed by a computer.

2. (Previously presented) The method of claim 1 wherein determining if each individual in the first population is influential comprises:

- a. formulating queries to be answered by an individual in the first population such that the answers by an individual in the first population indicate whether the individual has a greater probability than other individuals in the first population of influencing choices made by others;
- b. providing the queries to individuals in the first population; and
- c. analyzing the answers by the individuals in the first population to determine whether each of the individuals in first the population has a greater probability than other individuals in the first population of influencing choices made by others.

3. (Previously presented) The method of claim 2 wherein the choices made by others are selected from the group consisting of:

consumer product decisions, consumer service decisions, political issue decisions, political candidate decisions, personal finance decisions, investment decisions, real estate decisions, insurance decisions, travel decisions, and leisure decisions.

4. (Previously presented) The method of claim 2 wherein the queries are based on factors selected from the group consisting of:

written or called any politician at the state, local, or national level; attended a political rally, speech, or organized protest of any kind; attended a public meeting on town or school affairs; held or run for political office; served on a committee for some local organization; served as an officer for some club or organization; written a letter to the editor of a newspaper or magazine or called a live radio or TV show to express an opinion; signed a petition; worked for a political party; made a speech; written an article for a magazine or newspaper; and been an active member of any group that tries to influence public policy or government.

5. (Previously presented) The method of claim 2 wherein the queries are based on factors selected from the group consisting of:

written or called any politician or contacted any government official at local regional or national level; attended a political rally, speech or event; attended a public meeting on town or school affairs; led or served on a committee of some local organization; written a letter to the editor of a newspaper or magazine or called a live radio or TV show to express an opinion; made a speech or gave a talk to a group; been an active member of a group that tries to influence public policy or create change in the community; asked a question in a public meeting; made a complaint to a store, company, or organization; made a sizable donation to a local or national organization; attended business lunches or dinners on a regular basis, and organized a special social event.

6. (Currently amended) ~~A method for identifying from demographic data those individuals in a population having a greater probability than other individuals in the population of~~

influencing the choices made by others comprising computer-readable medium bearing a computer program containing instructions which, when implemented by a general purpose computer, cause the computer to implement the steps of:

- a. ~~determining if each individual in a first population is influential;~~
- b. ~~providing~~ receiving demographic data for each individual in ~~[[the]]~~ a first population, wherein the demographic data corresponds to a set of demographic variables;
- b. identifying a plurality of predictive variables from the set of demographic variables such that the demographic data corresponding to the plurality of predictive variables substantially correlates to an individual in the first population being determined to be influential;
- c. ~~reformatting the plurality of predictive variables into numeric representations of gains~~ calculating percent gains for each predictive variable as a measure of the correlation between the predictive variable and whether a person is an influential;
- d. creating a database scoring algorithm based upon the plurality of predictive variables and the percent gains; and
- e. validating the ~~plurality of predictive variables to determine a final set of predictive variables and to create a~~ database scoring algorithm~~[[;]].~~
- f. ~~providing demographic data for a second population, wherein the demographic data for the second population corresponds to the final set of predictive variables;~~
- g. ~~applying the database scoring algorithm to the demographic data for the second population to determine a group of influential individuals, wherein the group of influential individuals represent a subgroup of the second population that is predicted~~

~~to have a higher probability of being influential with respect to the second population in general.~~

7. The ~~method~~ computer-readable medium of claim 6 ~~wherein determining if each individual in the first population is influential comprises~~ containing further instructions which, when implemented by a general purpose computer, cause the computer to implement the steps of:

- a. ~~formulating queries to be answered by an individual in the first population such that the answers by an individual in the first population indicate whether the individual has a greater probability than other individuals in the first population of influencing choices made by others; calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status~~ receiving demographic data for a second population, wherein the demographic data for the second population corresponds to the predictive variables; and
- b. ~~providing the queries to individuals in the first population; and~~ applying the database scoring algorithm to the demographic data for the second population to generate a group of influential individuals, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population in general.
- c. ~~analyzing the answers by the individuals in the first population to determine whether each of the individuals in the first population has a greater probability than other individuals in the first population of influencing choices made by others.~~

8. The ~~method~~ computer-readable medium of claim [[7]] 6 wherein the ~~choices made by others are selected from the group consisting of~~ step of identifying a plurality of predictive variables from the set of demographic variables comprises:

~~consumer product decisions, consumer service decisions, political issue decisions, political candidate decisions, personal finance decisions, investment decisions, real estate decisions, insurance decisions, travel decisions, and leisure decisions.~~

- a. calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status; and
- b. selecting as potential predictive variables those demographic variables having an index value exceeding a pre-determined threshold index value.

9. (Canceled)

10. (Canceled)

11. (Currently amended) The method of claim[[s]] 1 ~~or 6~~ wherein the set of demographic variables is based on factors selected from the group consisting of:

household size, household income, occupation, presence of young adult in household, retail purchase activity, political affiliation, corrective lenses, golf participant, cd player owner, personal or home computer owner, pc operating system type, religious or inspirational reader, religiously active, active in theater or performing arts, active in general arts or culture, cell phone usage, personal income.

12 – 22. (Previously canceled).

23. (New) The method of claim 1 further comprising:

- a. providing demographic data for a second population, wherein the demographic data for the second population corresponds to the predictive variables; and
- b. applying the database scoring algorithm to the demographic data for the second population to generate a group of influential individuals, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population in general.

24. (New) The method of claim 1 wherein the step of identifying a plurality of predictive variables from the set of demographic variables comprises:

- c. calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status; and
- d. selecting as potential predictive variables those demographic variables having an index value exceeding a pre-determined threshold index value.

25. (New) The method of claim 1 wherein the step of identifying a plurality of predictive variables from the set of demographic variables comprises:

- e. calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status;
- f. calculating for each demographic variable a response rate; and
- g. selecting as predictive variables those demographic variables having both an index value exceeding a pre-determined threshold index value, and a response rate exceeding a pre-determined response rate threshold value.

26. (New) An apparatus for identifying from demographic data those individuals in a population having a greater probability than other individuals in the population of influencing the choices made by others comprising:

- a. a memory storing demographic data for each individual in a first population, wherein the demographic data corresponds to a set of demographic variables; and
- b. a processor programmed to perform the steps of:
 - identifying a plurality of predictive variables from the set of demographic variables such that the demographic data corresponding to the plurality of predictive variables substantially correlates to an individual in the first population being determined to be influential;
 - calculating percent gains for each predictive variable as a measure of the correlation between the predictive variable and whether a person is an influential;
 - creating a database scoring algorithm based upon the plurality of predictive variables and the percent gains.

27. (New) The apparatus of claim 26 wherein the processor is programmed to perform the additional steps of:

- a. receiving demographic data for a second population, wherein the demographic data for the second population corresponds to the predictive variables; and
- b. applying the database scoring algorithm to the demographic data for the second population to generate a group of influential individuals, wherein the group of influential individuals represent a subgroup of the second population that is predicted to have a higher probability of being influential with respect to the second population in general.

28. (New) The apparatus of claim 26 wherein the step of identifying a plurality of predictive variables from the set of demographic variables comprises:

- a. calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status; and
- b. selecting as potential predictive variables those demographic variables having an index value exceeding a pre-determined threshold index value.

29. (New) The apparatus of claim 26 wherein the step of identifying a plurality of predictive variables from the set of demographic variables comprises:

- a. calculating for each demographic variable a response index value, said response index value being indicative of the strength of the correlation between a demographic variable and influential status;

- b. calculating for each demographic variable a response rate; and
- c. selecting as predictive variables those demographic variables having both an index value exceeding a pre-determined threshold index value, and a response rate exceeding a pre-determined response rate threshold.

REMARKS

1. **Objection to the New Grounds of Rejection and the Examiner's Decision Not to Re-Open Prosecution**

In the Examiner's Answer dated October 30, 2008, the Examiner raised a new ground of rejection under 35 U.S.C. § 101. Applicants respectfully but strongly object to the Examiner's inclusion of a new ground of rejection in the Examiner's Reply as being contrary to the stated purpose of 37 C.F.R. 41.39(a)(2), and in violation of the guidelines set forth in MPEP § 1207.03. Rather than including the new ground of rejection in a reply brief, Applicants respectfully submit that the Examiner should have reopened prosecution of the application in accordance with MPEP § 1207.04.

Effective September 13, 2004, Section 41.39(a)(2) of 37 C.F.R. was amended to permit an Examiner to present a new ground of rejection in the examiner's answer to an appeal brief. In the comments accompanying the amendment to this section, the United States Patent and Trademark Office (USPTO) stated as follows:

By permitting examiners to include a new ground of rejection in an examiner's answer, *newly presented arguments* can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency.

It is envisioned that new grounds of rejection in examiner's answers *would be rare*, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, *e.g., responding to a new argument or new evidence submitted prior to appeal*, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution.

Rules of Practice Before the Board of Patent Appeals and Interferences, 69 Fed. Reg. 49,963 (Aug. 12, 2004) (emphasis added throughout). In its Appeal Brief, Applicants did not present any new argument or new evidence that would have required the new ground of rejection.

Accordingly, this new ground of rejection was not required to address a new argument by the Applicants, and should not have been included in the Examiner's Answer. Instead, as suggested by the USPTO's comments above, the new ground of rejection should have resulted in the Examiner reopening prosecution.

In addition, section 1207.03 of the MPEP provides restrictions on when new grounds of rejection are permissible, and is applicable here. The section provides, in part, as follows:

[I]f an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate.

In the Office Action dated August 23, 2007, the Examiner asserted that claims 1-11 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants subsequently amended the claims, placing them in the form in which they were presented for appeal. In the following Office Action dated February 25, 2008, the Examiner did not address Applicants' amendments and arguments that the claims were patentable under 35 U.S.C. § 101, but instead *withdrew* that rejection. In the recent Examiner's Answer, however, the Examiner sought to reject the *same claims* again under 35 U.S.C. § 101. In view of the fact that the Examiner had previously failed to address Applicants' argument, the Examiner cannot now add this new ground of rejection, but should instead reopen prosecution.

The consequences of the Examiner's decision to include the new ground of rejection in the Examiner's Reply rather than through reopening prosecution are not trivial. Because the new ground of rejection was included in the Examiner's Reply, Applicants are required by 37 C.F.R. § 41.39 to either maintain the appeal in view of the new ground of rejection without the benefit of amending the claims, or else reopen prosecution and, by doing so, withdraw the appeal. In effect, the Examiner has required Applicants to forfeit the appeal fees previously submitted in order to properly address the new ground of rejection. Were the new ground of rejection properly raised subsequent to reopening of prosecution by the Examiner, Applicants could apply their previously submitted appeal fees toward a subsequent appeal.

In its comments regarding the amendments to the rules of practice before the Board of Patent Appeals and Interferences, the USPTO stated that "[t]he making of a new ground of

rejection in an examiner's answer is in itself an acknowledgment of an error made in the rejection under appeal." 69 Fed. Reg. 49,979. Applicants should not now be prejudiced for an error they did not make. Accordingly, Applicants respectfully request that the Examiner withdraw the Examiner's Answer and instead reopen prosecution under MPEP § 1207.04 to allow for the proper entry of the new ground of rejection.

2. Summary of the Rejections

Claims 1-11 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of an archived selection of Burston-Marsteller web-sites, in view of a Burson-Marsteller press release entitled "Ninety Percent of Online Influentials Turn to Company Web Sites For Corporate Information, But Only 17 Percent Find Them Credible," and in further view of the Burson-Marsteller online publication "The E-fluentials."

In addition, claims 1-11 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

3. Status of the Claims

Claims 1, 6, 7, 8 and 11 have been amended. Claims 9 and 10 have been canceled without prejudice. Claims 12-22 were previously canceled. Claims 23-29 have been added. No new matter has been added by way of any amendments.

General support for these claim amendments can be found in paragraphs [0050]-[0057], [0098]-[0104], and [0114], and in Figures 1-9. In addition support for new claim 23 can be found in at least paragraphs [0094]-[0096]; support for new claims 24 and 25 can be found in at least paragraphs [0027], [0090], and [0101]-[0103] of the specification; and support for new claims 26-29 can be found in at least paragraphs [0050]-[0057] and [0094]-[0096].

Currently pending are claims 1-8, 11, and 23-29.

4. Response to the New Ground of Rejection Under 35 U.S.C. § 101

The stated test for determining whether a process is drawn to patentable subject matter under 35 U.S.C. § 101 is the "machine-or-transformation test." *In re Bilski*, 545 F.3d 943, 966 (Fed. Cir. 2008). Under this test, a claimed process is patentable if it is tied to a machine or if it results in a transformation of an underlying article is patentable under § 101. *Id.* at 961. Claim 1

is directed to a method wherein at least one of the steps of identifying a plurality of predictive variables, calculating percent gains, and creating a database scoring algorithm is performed by a computer. Accordingly, claim 1 passes the machine-or-transformation test for patentability for at least the reason that it is tied to a machine.

In addition, claim 1 also passes the machine-or-transformation test because it results in the transformation of an article. Through the steps of “identifying a plurality of predictive variables” and “calculating percent gains for each predictive variable,” the process of claim 1 manipulates demographic data and results in the creation of a database scoring algorithm. Accordingly, claim 1 transforms the underlying demographic data for a first population into a database scoring algorithm that can be applied to other sets of demographic data.

Without conceding the Examiner’s assertion that claims 1-11 as previously stated was directed to non-statutory subject matter, Applicants submit that claims 1-8 pass the machine-or-transformation test under either branch of the test, and are therefore drawn to patentable subject matter under 35 U.S.C. § 101. Furthermore, Applicants submit that the rejection of claims 9-11 under § 101 are moot in view of the cancellation of claims 8 and 9, and the amendments to claim 11. Lastly, Applicants submits that the embodiments of the invention in amended claims 6-8 and 23-29 are sufficient to place the claimed invention in patentable condition in view of 35 U.S.C. § 101. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 101 be withdrawn.

5. Response to the Rejection Under 35 U.S.C. § 103

Applicants respectfully submit that the Examiner’s obviousness rejection is improper and cannot be sustained because it fails to satisfy the statutory requirements of 35 U.S.C § 103(a) in view of relevant case law, thereby violating established doctrines for determining patentability. In rejecting claims under 35 U.S.C. § 103(a), an examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). In this regard, the key to establishing a rejection under 35 U.S.C. § 103 is the clear articulation by an examiner of the reasons why the claimed invention would have been obvious. M.P.E.P. § 2142.

A *prima facie* case of obvious does not exist because the cited references do not actually disclose or suggest each and every element of the invention as claimed; in contrast, the combined references actually teach away from the claimed invention. In addition, Applicants respectfully

submit that the Examiner's assertions of obviousness are invalid because they are improperly based on hindsight.

A. The References Do Not Teach or Suggest All Claim Limitations

To establish a *prima facie* case of obviousness through the combination of references, all claim limitations must be taught or suggested by the prior art references. *See, e.g.*, M.P.E.P § 2143.03 (stating that “all words in a claim must be considered in judging the patentability of that claim against the prior art”) (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In the present case, a *prima facie* case of obviousness does not exist because the references cited by the Examiner do not teach or suggest all the claim limitations of the independent claims. Although the prior art discloses a method of identifying individuals, this method can be seen as teaching, at most, only the first step of the claim 1. However, none of the references – either alone or in combination – teaches or suggests the steps of “identifying a plurality of predictive variables from the set of demographic variables . . .,” “calculating percent gains . . .,” “creating a database scoring algorithm . . .,” or “validating the database scoring algorithm.” In addition, none of the references – either alone or in combination – teaches or suggests the steps of “applying the database scoring algorithm to the second population to determine a group of influential individuals” Therefore the Examiner has not shown that all of the claim limitations are taught or suggested by the prior art references. For at least this reason, Applicants respectfully submit that all claims are unobvious over the prior art.

B. The References Teach Away from the Claimed Invention

Even if the references are interpreted as teaching the individual elements of the claimed invention, this is insufficient to establish a *prima facie* case of obviousness. The Supreme Court noted in *KSR* that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, a patent is invalid as obvious only if such a combination of the elements would have been obvious to an artisan of ordinary skill. 35 U.S.C. § 103.

In determining obviousness, the primary test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414,

425 (C.C.P.A. 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). In this regard, it is well-settled that a prior art reference must be considered in its entirety, including disclosures that teach away from the claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). When viewed in its entirety, the main reference relied upon by the Examiner teaches away from the claimed invention since, in reading the reference, a person of ordinary skill in the art would be deterred from following a path towards the claimed invention.

As noted above, the topic of demographics appears just once in the references cited by the Examiner, and this single discussion suggests that the claimed method of identifying influential individuals based on demographic information is entirely unfeasible. “The E-fluentials” contains a half-page discussion under the heading “Demographics” which begins by stating, “Overall, e-fluentials do not differ much from the general online population.” “The E-fluentials”, at 10. Although the discussion then mentions three minor differences between these two groups, it promptly dismisses them: “The overall similarities of the two populations means that e-fluentials cannot be identified by demographics alone.” *Id.* The discussion then concludes with the following definitive statement: “[e-fluentials] can only be found by closely examining their attitudes, perceptions and behaviors.” *Id.* Therefore, “The E-fluentials” definitively states that such a determination can only be made by examining purely non-demographic data (*i.e.*, attitudes, perceptions and behaviors).

Because “The E-fluentials” disparages the use of demographics in determining influentials, it suggests that the claimed method would not have been obvious to one of ordinary skill in the art at the time of the invention. *See In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986) (holding that proceeding contrary to accepted wisdom in the art is evidence of non-obviousness). Moreover, by specifically discouraging the concept of determining influentials based on demographic data, “The E-fluentials” teaches away from the claimed invention. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (stating that “in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant”). This teaching

away in the prior art is significant evidence of its patentability shows that the claimed invention is non-obvious.

C. The Examiner Improperly Relies on Hindsight for Support

Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the conclusion of obviousness. *See KSR Int'l*, 127 S.Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Moreover, rejections based on 35 U.S.C. § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968). In particular, when making an obviousness analysis based on prior art, courts must not fall prey to a “hindsight syndrome” by reasoning backward from the teaching of the patent itself. *See In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). In other words, an examiner cannot rely on the teachings of the claimed invention to support an obviousness rejection.

In this case, the Examiner’s arguments against the claimed invention appear to have been based upon hindsight bias and reconstruction. First, the Examiner’s interpretation of the teachings of the prior art strongly suggests reliance on hindsight. The Examiner interpreted the phrase “[t]he overall similarity of the two populations means that e-fluentials cannot easily be identified by demographics alone” as implying that demographic variables are used to differentiate e-fluentials. Examiner’s Answer, p. 13. However, as discussed above, this interpretation is in clear conflict with the references as a whole, which actually disparage the use of demographic variables for determining influential status. Thus, when viewed separate from the teachings of the Applicants, it is apparent that this phrase does not suggest the use of demographics to identify influentials. Only through the benefit of the Applicants’ insight could the Examiner’s interpretation be deemed reasonable. *See Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (discussing the “importance of guarding against hindsight . . . and resist[ing] the temptation to read into the prior art the teachings of the invention in issue” when considering the obviousness of a patent).

Second, it appears that the Examiner improperly relied on conclusory statements that are based solely on the teachings of the Applicants. In particular, the Examiner asserted that within the references it is established that demographic variables are “determined to be useful and

predictive of the most influential people in a group.” Examiner’s Answer, p. 10. However, the Examiner did not cite any specific teachings in the references or any other prior art to support this assertion. Moreover, in direct contrast to the Examiner’s assertion, the references reach the exact opposite conclusion and dismiss demographic variables as ineffective predictors of influential status, and discourage their use. “The E-fluentials”, at 10. Thus, it is only in view of the claimed invention that the usefulness of demographic variables in identifying influentials becomes apparent.

As the Examiner’s above arguments appear to have been based on hindsight, they cannot properly be relied upon by to support the rejection of the claims for obviousness. Further, because the Examiner did not otherwise provide support for these arguments, a *prima facie* case of obviousness does not exist and the claims are patentable over the prior art.

6. Conclusion

For the foregoing reasons, Applicants submit that all claims are in condition for allowance and respectfully request notice to that effect. The Examiner is invited to call the undersigned at 312-701-8533 to discuss any aspect of the case or to expedite its prosecution.

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